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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRAN, PHUC H

ART UNIT

PAPER NUMBER

2664

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

311

**Office Action Summary**

Application No.

09/259,757

Applicant(s)

LEE, RONALD B.

Examiner

PHUC H TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7 and 10-24 is/are rejected.
- 7) ☒ Claim(s) 3,4,8,9,25 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10-13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-2, 5-7, & 10-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Fijolek et al. (U.S. Patent No. 6240646 B1).

- With respect to claims 1 & 16, Fijolek teaches an improved communication system comprising a customer premises equipment (block 18 in Fig. 1) connected to a data network (block 28 in Fig. 1) via a network connection (block 10 in Fig. 1), the customer premises equipment being operable to communicate with the data network when configured with a client

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network address (e.g. the CPE received IP address before communicate with the data network through block 10 in Fig. 1), the customer premises equipment being operable to issue configuration messages to a configuration server connected to the data network to retrieve the client network address from the configuration server (col. 2, lines 31-46), the improvement comprises: a temporary configuration server for responding to configuration messages from the customer premises equipment before the network connection is capable of connecting the customer premises equipment to the data network (col. 2, lines 41-46).

- With respect to claim 2, Fijolek discloses the network connection comprising a communications device for connecting the customer premises equipment to a local network (e.g. block 20 in Fig. 1), the local network being connected to the data network via a network interconnection device (e.g. block 26 in Fig. 1).

- With respect to claim 5, Fijolek also teaches the communications device includes a cable modem (block 16 in Fig. 1), the local network includes a cable network (block 14 in Fig. 1) and the network interconnection device includes a cable modem termination system (block 12 in Fig. 1).

- With respect to claim 6, Fijolek teaches the cable network is a bi-directional cable network (e.g. Fig. 1 shows the cable network is bi-directional).

- With respect to claim 7, Fijolek discloses the local network further includes a general switched telephone network (block 22 in Fig. 1); the cable modem includes a telephone connection to the general switched telephone network (shows in Fig. 1 block 16 connects to block 22); and the network interconnection device includes a telephony remote access

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concentrator for sending messages from the cable modem to the data network (e.g. block 24 in Fig. 1).

- With respect to claims 10 & 17, Fijolek teaches the configuration server is a dynamic host configuration protocol server (e.g. block 66 in Fig. 3).

- With respect to claim 11, Fijolek further teaches the network address used by the customer premises equipment is an Internet protocol address (col. 8, line 61).

- With respect to claims 12 & 18, Fijolek teaches wherein the temporary configuration server responds to configuration messages with a temporary network address (e.g. block 66 in Fig. 2 provides configuration parameters for network host interface).

- With respect to claims 13, 19 & 24, Fijolek discloses wherein the temporary configuration server responds to configuration messages with a lease time for setting a time limit for the temporary network address (col. 4, lines 31-36).

- With respect to claims 14 & 20, Fijolek teaches wherein the lease time is less than 10 seconds (col. 30, lines 35-41).

- With respect to claims 15 & 22, Fijolek also teaches wherein the data network includes a connection to the Internet (see bridge paragraph between col. 1 & 2).

- With respect to claim 21, Fijolek wherein the cable modem configuration protocol client declines to renew the temporary network address when the cable modem is capable of connecting the customer premises equipment to the data network (col. 22, lines 33-45).

- With respect to claim 23, Fijolek a method for ensuring a connection to a configuration protocol server on a data network by a customer premises equipment via a network connection (e.g. Fig. 1), the method comprising the steps of: issuing a request for a customer premises

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equipment network address from the customer premises equipment to the configuration protocol server via the network connection (e.g. the CPE establish a connection through CM 16 and to telephone remote access concentrator for communication); the network connection determining whether a connection can be made to the configuration protocol server, and if not, responding to the customer premises equipment by sending a temporary network address to the customer premises equipment (col. 2, lines 18-47).

***Allowable Subject Matter***

4. Claims 3-4, 8-9 & 25-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Carr et al. (U.S. Patent No. 5608446) discloses apparatus and method for combining high bandwidth and low bandwidth data transfer.

- Majeti et al. (U.S. Patent No. 5675731) discloses dynamic channel assignment for TCP/IP data transmitted via cable television channels by managing the channels as a single sub network.

- Lee et al. (U.S. Patent No. 5958007) discloses automatic and secure system for remote access to electronic mail and the Internet.

- Jones et al. (U.S. Patent No. 5903558) discloses method and system for maintaining a guaranteed quality of service in data communication system.

- Wong et al. (U.S. Patent No. 6073178) discloses method and apparatus for assignment of IP addresses.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H TRAN whose telephone number is (703) 308-7471. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WELLINGTON CHIN can be reached on (703) 305-4366. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9314.

Phuc Tran  
Assistant Examiner  
Art Unit 2664

P.t  
June 14, 2002

  
RICKY NGO  
PRIMARY EXAMINER